

**REMARKS**

At the time of the Office Action dated April 4, 2007, claims 1-20 were pending and rejected in this application.

**CLAIMS 1-13 ARE REJECTED UNDER 35 U.S.C. § 101**

On pages 2 and 3 of the Office Action, the Examiner asserted that the claimed invention, as recited in claims 1-13, is directed to non-statutory subject matter. This rejection is respectfully traversed.

In the paragraph spanning pages 2 and 3 of the Office Action, the Examiner asserted the following:

Claims 1-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The current focus of the Patent Office in regard to statutory inventions under 35 U.S.C. § 101 for method claims and claims that recite a judicial exception (software) is that the claimed invention recite a practical application. Practical application can be provided by a physical transformation or a useful, concrete and tangible result. No physical transformation is recited and additionally, the final result of the claims is not a useful, concrete and tangible result.

It appears that the Examiner has misinterpreted the current focus of the Patent Office. Regardless of whether or not the claims recite an alleged judicial exception (i.e., "(software)'), to meet the requirements of 35 U.S.C. § 101, all claimed inventions are required to produce a useful, concrete and tangible result. Also, Applicants respectfully request that the Examiner produce case law to support the Examiner's assertion that "(software)" is a "judicial exception," since Applicants are aware of only three exceptions to statutory subject matter: laws of nature, abstract ideas, and natural phenomena.

As to the Examiner's assertion that "the final result of the claims is not a useful, concrete and tangible result," the Examiner has neither identified the result nor why the result is neither useful, concrete nor tangible. As stated in M.P.E.P. § 2106(II)(A):

Office personnel have the burden to establish a *prima facie* case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101. Compare *Musgrave*, 431 F.2d at 893, 167 USPQ at 289; *In re Foster*, 438 F.2d 1011, 1013, 169 USPQ 99, 101 (CCPA 1971). Further, when such a rejection is made, Office personnel must expressly state how the language of the claims has been interpreted to support the rejection.

The Examiner, however, has not made any *prima facie* case. Instead, the Examiner's has merely concluded that the claimed invention, as recited in the claims, does not produce a useful, concrete, and tangible result without explaining why.

Also, Applicants note that the Examiner has applied an improper standard with regard to the requirement enunciated in State Street Bank & Trust Co. V. Signature Financial Group, Inc.<sup>1</sup> that the claimed invention produces a "useful, concrete, and tangible result." Absent from State Street Bank is a requirement that the claims themselves recite the useful, concrete, and tangible result. Instead, as noted in M.P.E.P. § 2106 (IV)(C)(2)

USPTO personnel shall review the claim to determine it produces a useful, tangible, and concrete result. In making this determination, the focus is not on whether the steps taken to achieve a particular result are useful, tangible, and concrete, but rather on whether the final result achieved by the claimed invention is "useful, tangible, and concrete."

Reference is also made to the second paragraph of 35 U.S.C. § 112, which is reproduced below:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The second paragraph of 35 U.S.C. § 112 sets forth the requirements for the claims, yet absent from this paragraph is a requirement that the claims themselves recite a useful, concrete, and tangible result or any requirements associated with satisfying 35 U.S.C. § 101. Instead, the

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<sup>1</sup> 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1999).

requirement is that the claimed invention produces a useful, tangible, and concrete result.

Regarding the system claims 1-6, Applicants note that a system is a structural device. For example, claim 1 recites "a communication layer programmed to ..." An abstract idea is incapable of being "programmed." Instead, hardware (i.e., structure) is programmed.

As to method claims 7-13, the Examiner is directed to U.S. Patent No. 5,333,184 (hereinafter the '184 patent). Claim 1 of the '184 patent is reproduced below:

1. A method for use in a telecommunications system in which interexchange calls initiated by each subscriber are automatically routed over the facilities of a particular one of a plurality of interexchange carriers associated with that subscriber, said method comprising the steps of:

generating a message record for an interexchange call between an originating subscriber and a terminating subscriber, and

including, in said message record, a primary interexchange carrier (PIC) indicator having a value which is a function of whether or not the interexchange carrier associated with said terminating subscriber is a predetermined one of said interexchange carriers.

Upon reviewing this claim, while considering the Examiner's rejection of method claims 7-13 of present application, it appears that the Examiner would reject claim 1 of the '184 patent for the same reason. Applicants have referred to the '184 patent because this patent was the subject of the decision by the Federal Circuit in AT&T Corp. v. Excel Communications, Inc.<sup>2</sup> The conclusion of the Federal Circuit with regard to the '184 patent is "we find that the claimed subject matter is properly within the statutory scope of 101." If the Examiner is to maintain the

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<sup>2</sup> 172 F.3d 1352, 50 USPQ2d 1447 (Fed. Cir. 1999).

rejection of method claims 7-13, Applicants respectfully request the Examiner to explain what is the significant difference between claim 1 of the '184 patent and claims 7-13 of the present application which leads to the conclusion that claims 7-13 of the present application are directed to non-statutory subject matter, whereas claim 1 of the '184 patent is directed to statutory subject matter.

In the first full paragraph on page 3 of the First Office Action, the Examiner further asserted the following:

Claims which are broad enough to read on statutory subject matter or on non-statutory subject matter are considered non-statutory. Cf. In re Lintner, 458 F.2d 1013, 1015, 173 USPQ 560, 562 (CCPA 1972) ("Claims which are broad enough to read on obvious subject matter are unpatentable even though they also read on nonobvious subject matter.") During prosecution, applicant can amend to limit the claims to statutory subject matter.

At the outset, Applicants note that the Examiner has inappropriately applied the holding of In re Lintner. This case was directed to determining whether the claims were broad enough to encompass subject matter that qualified as prior art under 35 U.S.C. § 103.

Even if the claims could be construed to cover non-statutory subject matter, this fact alone is not dispositive with regard to a rejection under 35 U.S.C. § 101. The entire text of § 101 is reproduced below:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

In comparison, 35 U.S.C. § 102<sup>3</sup> which states "[a] person shall be entitled to a patent unless ..." (emphasis added). The difference between § 101 and § 102 of 35 U.S.C. is that 35 U.S.C. § 102 states that if the claims cover certain subject matter (i.e., anticipatory prior art), then the inventor shall not be entitled to a patent. On the contrary, whereas the existence of a single piece of anticipatory prior art excludes a patent from granting under § 102, § 101 is not similarly written. Instead, 35 U.S.C. § 101 only requires that the claimed invention cover statutory subject matter and does not explicitly prevent a patent from issuing if the claimed invention also covers non-statutory subject matter.

The logic behind this notion is best illustrated by considering the consequences if the Examiner's legal assertion was, in fact, correct. It is well-established that a non-functional (i.e., inoperable) device is non-statutory, and the Patent Office has determined that utility, for example, as landfill or as a paperweight, does not meet the utility requirements of 35 U.S.C. § 101. Thus, an inoperable device would be considered to be non-statutory subject matter.<sup>4</sup>

Most patentable claims, however, cover inoperable devices and, thus, non-statutory subject matter. For example, few claims that cover a computer actually recite a power source, but a computer is inoperable without a power source. These claims, nevertheless, cover non-operable computers that do not include power sources.

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<sup>3</sup> Section 103 of 35 U.S.C. qualifies prior art using 35 U.S.C. § 102.

<sup>4</sup> See M.P.E.P. § 2107.01(II):

An invention that is "inoperative" (i.e., it does not operate to produce the results claimed by the patent applicant) is not a "useful" invention in the meaning of the patent law. See, e.g., Newman v. Quigg, 877 F.2d 1575, 1581, 11 USPQ2d 1340, 1345 (Fed. Cir. 1989); In re Harwood, 390 F.2d 985, 989, 156 USPQ 673, 676 (CCPA 1968) ("An inoperative invention, of course, does not satisfy the requirement of 35 U.S.C. 101 that an invention be useful.").

Similarly, few claims recite all the features necessary to make a particular invention operable. Therefore, it is readily apparent that nearly all claims are capable of covering subject matter, which is defined solely by the claims, could be considered non-statutory subject matter. Thus, if the Examiner's legal assertion was correct, then most claims would be rejected under 35 U.S.C. § 101. Since the Examiner's proposed "test" is clearly not being employed, the test as to whether or not a claim satisfies the requirement of 35 U.S.C. § 101 does not involve determining whether or not a claim could cover some subject matter that is deemed non-statutory involves. Instead, the test involves determining whether the claim covers some statutory subject matter.

Therefore, for the reasons stated above, Applicants submit that the imposed rejection of claims 1-13 under 35 U.S.C. § 101 is not viable. Thus, Applicants respectfully solicit withdrawal thereof.

**CLAIMS 1-20 ARE REJECTED UNDER 35 U.S.C. § 102 AS BEING ANTICIPATED BY GASE, U.S. PATENT No. 6,363,081**

On pages 3-9 of the Office Action, the Examiner asserted that Gase discloses the invention corresponding to that claimed. This rejection is respectfully traversed.

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure of each element of a claimed invention in a single reference.<sup>5</sup> As part of this analysis, the Examiner must (a) identify the elements of the claims, (b) determine the meaning of the elements in light of the specification and prosecution history, and (c) identify corresponding

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<sup>5</sup> In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

elements disclosed in the allegedly anticipating reference.<sup>6</sup> This burden has not been met. Moreover, the Examiner has failed to clearly designate the teachings in Gase being relied upon the statement of the rejection. In this regard, the Examiner's rejection under 35 U.S.C. § 102 also fails to comply with 37 C.F.R. § 1.104(c), which reads:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

Despite these requirements, the Examiner's statement of the rejection simply consists of the Examiner repeating, almost word-for-word, each of the recited claims and asserting that the entire claim is disclosed by certain specified passages within Gase. The manner in which the Examiner conveyed the statement of the rejection, however, has not "designated as nearly as practicable" the particular parts in Gase being relied upon in the rejection.

It is practicable for the Examiner, for each of the claimed elements, to specifically identify each feature within Gase being relied upon to teach each of the particular claimed elements. For example, the Examiner can "specifically identify" a feature, corresponding to the claimed element, within the applied prior art by identifying a reference numeral associated with the feature. In addition to or alternatively, the Examiner may cite to a brief passage (i.e., 1 or 2 lines or even a portion of a line) within the applied prior art that identifies the feature that corresponds to the claimed element. However, merely citing a long passage, an entire paragraph, or several columns to disclose a single (or multiple) claimed elements does not designate "as

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<sup>6</sup> Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., supra.

nearly as practicable," the particular features within Gase being relied upon by the Examiner in the rejection.

The importance of the specificity requirement of 37 C.F.R. § 1.104(c) is evident in M.P.E.P. § 706.07, which states:

The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal.

A clear issue, however, cannot be developed between Applicants and the Examiner where the basis for the Examiner's rejection of the claims is ambiguous. The Examiner's "analysis" provides little insight as to (i) how the Examiner is interpreting the elements of the claims and (ii) what specific features within Gase the Examiner believes identically discloses the specific elements (and interactions between elements) recited in the claims. By failing to specifically identify those features within Gase being relied upon in the rejection, the Examiner has essentially forced Applicants to engage in mind reading and/or guessing to determine how the Examiner is interpreting the elements of the claims and what specific features within Gase the Examiner believes identically disclose the claimed invention.

As noted by the Supreme Court in Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.,<sup>7</sup> a clear and complete prosecution file record is important in that "[p]rosecution history estoppel requires that the claims of a patent be interpreted in light of the proceedings in the PTO during the application process." The Courts that are in a position to review the rejections set forth by the Examiner (i.e., the Board of Patent Appeals and Interferences, the Federal Circuit, and the Supreme Court) can only review what has been written in the record; and therefore, the

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<sup>7</sup> 535 U.S. 722, 122 S.Ct. 1831, 1838, 62 USPQ2d 1705, 1710 (2002).

Examiner must clearly set forth the rationale for the rejection and clearly and particularly point out those elements within the applied prior art being relied upon by the Examiner in the statement of the rejection.

Essentially, the Examiner is placing the burden on Applicants to establish that Gase does not disclose the claimed elements based upon Applicants' interpretation of the claims and Applicants' comparison of the claims with the applied prior art. However, this shifting of burden, from the Examiner to Applicants, is premature since the Examiner has not discharged the initial burden of providing a *prima facie* case of anticipation. Applicants also note that any continuing disagreement between Applicants and the Examiner as to whether or not a particular claimed feature is disclosed by Gase is a direct result of a lack of specificity by the Examiner in the statement of the rejection

Although Applicants' analysis of the Examiner's rejection has been greatly hampered by the lack of specificity in the Examiner's stated analysis, Applicants refer to the following claimed limitations respectively found in claims 1, 2, 7, and 11: "programmed to moderate access," "programmed to select a particular one of said application process and protocols in said list," "selecting a particular application/protocol layer in a higher one of said two layers," and "a particular application/protocol layer ... is selected to receive traffic flowing through the hierarchy." In contrast to these limitations, reference is made to column 3, lines 46-55, which is reproduced below:

The primary application 30 listens to all incoming data packets on the contested port 34. When a data packet is received, the primary application 30 delivers a copy of the data packet over the registration port 36 to all secondary applications registered in the distribution list 38. The primary and secondary applications are then free to consume the data packets for their own

processes. In this manner, a data packet destined for a single contested port can be conveniently shared among multiple applications executing on the client computer 24.

As evident from this passage, Gase does not teach that access has been moderated to all of the application/protocols in the layered hierarchy or that a particular application/protocol has been selected. Instead, Gase teaches that the primary application sends a copy of the data packet to all the secondary applications (i.e., 32(1), 32(2) ... 32(N)). Thus, Gase fails to identically disclose, within the meaning of 35 U.S.C. § 102, all of the claimed limitations recited in the claims.

Therefore, for the reasons stated above, Applicants submit that the imposed rejection of claims 1-20 under 35 U.S.C. § 102 for anticipation based upon Gase is not viable. Thus, Applicants respectfully solicit withdrawal thereof.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: July 2, 2007

Respectfully submitted,

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